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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of

John M. CARNAHAN, III

Art Unit: 3643

Serial No.: 10/743,380

Examiner: Parsley, D. J.

Filed: December 23, 2003

For: METHOD AND DEVICE FOR DETECTING FISHING CONDITIONS

BRIEF ON APPEAL

This appeal is from the final rejection dated August 9, 2005, of claims 1, 2, and 4-11. A Notice of Appeal was timely filed on September 16, 2005 along with a Pre-Appeal Request for Review. A Decision on the Pre-Appeal Request for Review was rendered on November 3, 2005.

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REAL PARTY IN INTEREST

The real party in interest in the application is the Appellant John M. CARNAHAN, III.

STATEMENT OF RELATED APPEALS AND INTERFERENCES

There are no prior or pending appeals, interferences or judicial proceedings known to Appellant or Appellant's legal representative that may be related to, directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1, 2, and 4-7, 9, and 10 stand finally rejected under 35 U.S.C. § 102(b) as unpatentable over U.S. Patent No. 5,722,196 to Flynn.

Claims 5 and 6 stand finally rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,722,196 to Flynn.

Claims 8 and 11 stand finally rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,722,196 to Flynn and United States Patent No. 1,036,574 to Crane. The full texts of claims 1, 2, and 4-11 may be found in the Claims Appendix.

STATUS OF AMENDMENTS

No amendments were filed subsequent to the final rejection. All amendments have been entered.

SUMMARY OF THE CLAIMED SUBJECT MATTER

Independent claim 1 recites a method of detecting fishing conditions to allow for selection of a proper fishing lure by first providing a screening device having an elongated frame. The elongated frame supports an elongate screen, the screen being attached to the frame to form a curved configuration in use. Side rails of the frame can have one or more handle portions displaced from the screen and one or more support portions. The frame can be supported by the one or more handle portions, whereby a user inserts at least a portion of the frame and screen into shallow water. The frame is oriented in the water so the elongate screen spans a depth of the water, preferably extending from near a bottom of the shallow water to near a surface of the shallow water. The screening device is left in the water for a period of time to collect organisms in the water on the screen. The collected organisms are then inspected and based on the inspection, the proper fishing lure can be selected. Page 10, lines 6-20 of the specification describes the method of collecting organisms, and one step is illustrated in Figure 4.

Independent claim 7 describes the screening device, which comprises the frame and flexible screen. The frame has a pair of side rails and at least two cross members, the cross members interconnecting the pair of side rails. The side rails include at least one handle portion and one support portion, see page 7, line 11 to page 8, line 16 and Figure 1.

The flexible screen has opposing ends and opposing sides, each opposing side aligned and attached to a respective side rail, at least one opposing end being a free end and extending between the pair of side rails, the flexible screen having a width such that the free end is curved in shape during use. The screen is detailed on page 9 of the specification.

The folding aspect of the screen as detailed in claims 8 and 11 is described on page 7, line 17 to page 8 line 16. In this embodiment, each of the segments 7

is mounted to the rail 1 with each of the segments 9 mounted to the rail 3. Each of segments 7 and 9 are pivotally connected together to allow the screening device to be collapsed for storage and/or transport.

GROUNDΣ OF REJECTION TO BE REVIEWED ON APPEAL

Appellant seeks review of the rejection of Claims 1 and 7 under 35 U.S.C. § 102(b) based on Flynn and review of the rejection of Claims 8 and 11 based on Flynn and Crane.

ARGUMENT

Introduction

One issue in this appeal is whether Flynn anticipates claims 1 and 7. A second issue on appeal is whether Flynn and Crane establish a *prima facie* case of obviousness against claims 8 and 11. Because the Office Action wholly fails to establish even a *prima facie* case of anticipation with respect to claims 1 and 7, and a *prima facie* case of obviousness against claims 8 and 11, the final rejection must be reversed and this application passed to issue.

The References

Flynn

Flynn teaches an aquatic seine device which has a pair of vertical members 12 and 14 and a pair of horizontal members 16 and 18. Two flexible cords 36 and 38 are provided along with two cross members 40 and 42 and a flexible net 52, see col. 3, lines 19-26. As shown in Figure 3, the vertical members 12 and 14 pivot with respect to the horizontal members 16 and 18, see also, col. 5, lines 8-35.

The cords 36 and 38 connect between ends of the vertical members 12 and 14 and ends of the horizontal members 16 and 18 to facilitate positioning of the device, see col. 4, lines 4-22.

The net 52 is adapted to be secured to the vertical members 12 and 14, see col. 4, lines 63 and 64. See also col. 5, lines 34-36, wherein the net is

described as being secured to the vertical members 12 and 14. The attachment of the net 52 to the vertical members 12 and 14 is also recited in claim 1, col. 8, lines 20 and 21.

Referring to col. 5, lines 63 and the operation of the device, the horizontal members 16 and 18 are placed parallel to each other. The vertical members are pivoted to their vertical position and secured in this position. The cross members are unfolded and are used to link the two horizontal members together. The assembled device is placed in water for sampling using the cords 36 and 38.

Crane

Crane describes a means for catching and entrapping minnows. The means is shown in Figure 1 in a position suspended from line 12. The arms 3 of the device are designed to spread when the device is lowered into the water, see Figure 1, and then collapse when leaving the water, see Figure 2. As part of the moving arm arrangement, the arms 3 are pivotally attached to sleeve 2, see col. 1, lines 55 and 56. The arms 3 are held in their extended position by spreaders 6, see col. 2, lines 65-76. The outer ends of the spreaders 6 are pivotally secured to the arms and the inner ends of the spreaders 6 are pivotally attached to the ferrule 7. The ferrule 7 is held in its normal position by spring latch 8, see Figure 1. Pulling on the line 12 causes the latch 8 to move inwardly so as to allow the ferrule 7 to move down. This downward movement releases the pressure on the arms 3 and allows them to collapse for trapping of minnows, see col. 2, lines 90-102.

The PTO Has Failed to Present a *Prima Facie* Case of Anticipation

Claim 1

In the rejection of claim 1, the Examiner took the position that the placing the horizontal rails 16 and 18 on a bed of gravel was the same as the claimed inserting step. The Examiner referenced Figures 5-7 to support this contention.

It is contended that Flynn does not teach the insertion step of claim 1. Claim 1 requires that one or more support portions of the frame are embedded in a bed underlying the water as part of the insertion step. This is not a functional limitation in an apparatus claim even if the “embedded” in claim 1 is used in past tense. Claim 1 is a method claim wherein the embedding step is part of the insertion step. It is error for the Examiner to ignore the embedding limitation of claim 1, and this is grounds for withdrawing the rejection or reopening prosecution.

In Flynn, the placement of the seine device is explained in col. 5, lines 36-63. In this description, the seine device is “placed in said running water” and a “rock or other relatively heavy object” is used to secure the device in place. The Examiner also contends that placing the rock on the cross bar causes an embedding of a support portion of the frame. This position fails since laying the members 16 and 18 and cross bar on a bed, even if weighted, is not the same as embedding the one or more support portions in a bed as part of the insertion step of placing the frame into shallow water. Moreover, Appellant contends that the step of embedding is more than laying the device of Flynn in a bed that may have

a sandy bottom; this is not embedding. Therefore, the rejection of claim 1 is in error and the Examiner should be directed to withdraw the rejection.

Claim 7

Claim 7 of the application defines a frame with a pair of side rails, and a flexible screen having its opposing sides aligned with and attached to a respective side rail.

In the rejection, the Examiner contends that the claimed side rails are the horizontal members 16 and 18 of Flynn. With this interpretation, the Examiner further contends that the net 52 is attached to the members 16 and 18 to meet the claim limitation that the flexible screen has its opposing sides aligned with and attached to a respective side rail.

It is respectfully submitted that the Examiner's interpretation of the teachings of Flynn is factually incorrect. The Board's attention is again directed to col. 4, lines 63 and 64 and col. 5, lines 34 and 35 of Flynn. Each of these sections of Flynn teaches that the screen is attached to the vertical members 12 and 14. This is reiterated in col. 8, lines 20 and 21. These disclosures make it quite clear that the net 52 of Flynn is attached to the pivoting members 12 and 14. This interpretation is the only one that makes sense since it is the members 12 and 14 that are placed upright to orient the net 52 for aquatic sampling.

The rejection of claim 7 is predicated on the sentence relied upon by the Examiner, which is reproduced below

Said assembled aquatic seine device 10 with said attached flexible net 52 is placed in said running water to be sampled by having said

plurality of two parallel L-shaped horizontal members with said attached flexible net 52 facing into said running water.... .

The Examiner contends that "horizontal members with said attached flexible net 52" means that the net 52 is attached to the members 16 and 18. It is submitted that a fair reading of the entire Flynn disclosure means that "said attached flexible net 52" refers to the previous mention of the attached net, which is found in col. 5, lines 34 and 35, and this previous section clearly teaches that the net is attached to the members 12 and 14. The interpretation that the net 52 is attached to the members 12 and 14 is supported by three separate disclosures as noted above. There is no teaching whatsoever in Flynn to confirm that the phrase "said attached flexible net 52" means that the net is attached to the members 16 and 18. The Examiner is ignoring the rest of Flynn to draw the conclusion that somehow the net 52 is attached to members 16 and 18.

Moreover, the phrase "said attached flexible net 52" is used first in line 37 of col. 5, and this clearly would reference the previous sentence stating that the net 52 is secured to the members 12 and 14. There is nothing to suggest that the second recitation of this phrase on line 40 would somehow have a different interpretation, i.e., the net is now secured to members 16 and 18.

In addition, Figures 1 and 4 show that the net 52 must be attached to at least members 12 and 14 to allow it to unfurl. Therefore, the Examiner's cannot ignore the fact that regardless of the question of attachment to members 16 and 18, Flynn teaches that the net must be attached to both members 12 and 14. Since the net 52 must attach to members 12 and 14 for operation of the seine

device, why also attach it to members 16 and 18? The fact that Flynn teaches attachment to members 12 and 14 weighs against the conclusion that the net 52 is attached to members 16 and 18.

Col. 5, lines 1-6 describe the net 52 as removable from the device components. If the net has to be removed, why would it be attached to the lower members when no function or teaching is provided as to why such an attachment is needed? The fact that there is no explanation of why the net 52 needs to be attached to the members 16 and 18 further substantiates Appellant's contention that the net 52 of Flynn is only attached to the members 12 and 14.

The Examiner also alludes to the fact that since screen forms the shape of the side rail it is attached thereto. This is considered speculation on the part of the Examiner. The screen shown in Figures 1, 6, and 7 is the screen in use in water. Admittedly, these Figures show that the screen edge does align with horizontal members 16 and 18. However, this alignment can also be a result of the fact that these Figures show the device in water. These Figures cannot depict the device out of the water because the screen could not be in the billowed configuration. With no water flow to billow the screen, gravity would require the screen to hang from its two attachment points at the top of vertical members 12 and 14. The only reasonable conclusion to be drawn is that the screen position shown in Figures 1, 6, and 7, especially given the fact that the screen bottom sides are aligned with the horizontal members 16 and 18 is a result of the water flow and not because the screen is somehow attached to the horizontal members.

While the Examiner is permitted to give the claims their broadest interpretation, the Examiner cannot merely speculate on the meaning of the prior art. The prior art should be examined through the eyes of a person of ordinary skill in the art for its meaning. *Schering Corporation v. Geneva Pharmaceuticals, Inc.*, 339 F.3d 1373; 67 U.S.P.Q.2D 1664 (Fed. Cir. 2003). One of skill in the art faced with the overwhelming description of the attachment of the net to the vertical members 12 and 14 could not come to the conclusion that the net 52 is attached to the horizontal members 16 and 18.

It is respectfully submitted that the Examiner's interpretation of the teachings of Flynn is incorrect, and Flynn does not teach a flexible screen with its opposing sides aligned and attached to the side rails as set forth in claim 7. Lacking this claimed feature, the rejection based on 35 U.S.C. § 102(b) is improper and must be reversed.

The PTO Has Failed to Present a *Prima Facie* Case of Obviousness

For claims 8 and 11, the issue is whether it would be obvious to modify Flynn so that each of the cross members 40 and 42 would be made into pivotally connected cross segments. In the rejection, the Examiner contends that the connection between arms 3 and spreaders 6 is a pivotal one and that one would be motivated to connect the arms 40 and 42 together in a pivotal fashion so as to "allow for the device to be easily folded up for storage and or transportation."

The mere fact that Crane has a pivotal connection does not lead to the conclusion made by the Examiner that it would be obvious to make the cross members of Flynn into two pivotal parts. While the Examiner contends that members 3 and 6 of Crane are pivotally attached together, member 6 is really pivotally connected to a sleeve (unmarked in the Crane figures) that is attached at a midpoint of member 3, with another end mounted to the movable ferrule 7. Claim 8 requires that each segment has one end pivotally attached to the side rail with each of the other ends of the segments attached together. Crane teaches no such arrangement. In addition, Crane employs a totally different member movement than that contemplated by the invention and Flynn, and has no relevance with respect to the single cross bar of Flynn. Therefore, the rejection of claims 8 and 11 is also in error.

CONCLUSION

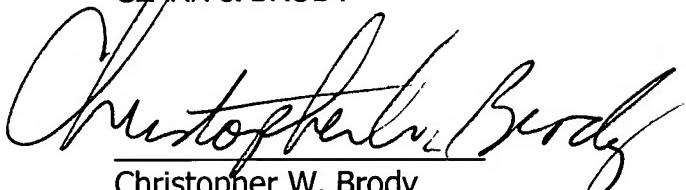
The final rejection being in error, therefore, Appellant respectfully requests that the Honorable Board of Patent Appeals and Interferences reverse the Office Action's decision in the present application regarding the rejection of claims 1, 7, 8, and 11 indicate that claims 1, 2, and 4-11 are allowable.

Appellant submits that this Appeal Brief is being timely filed and meets the requirements set forth under 35 U.S.C. § 134 and in 37 C.F.R. § 41.37.

Appellant petitions for a two month extension of time to extend the deadline for filing this Appeal Brief until February 3, 2006. Enclosed is a check

for \$ 475.00 to cover the extension of time fee and Appeal Fee. Any further necessary extensions of time are requested. Please charge any fee deficiency and credit any excess to Deposit Account 50-1088.

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CLAIMS APPENDIX

1. A method of detecting fishing conditions to allow for selection of a proper fishing lure comprising:

a) providing a screening device having an elongated frame, the elongated frame supporting an elongate screen, the screen attached to the frame to form a curved configuration in use;

supporting the frame whereby a user inserts at least a portion of the frame and screen into shallow water, with the frame oriented so the elongate screen spans a depth of the water near a bottom of the shallow water and close to a surface of the water;

maintaining at least a portion of the frame in the water for a period of time to collect organisms in the water on the screen;

removing the portion of the frame and screen from the water and inspecting the screen for collected organisms; and

selecting the fishing lure based on the organisms collected;

wherein the frame has one or more support portions and one or both of the support portions are embedded in a bed underlying the water as part of the insertion step.

2. The method of claim 1, wherein the frame is collapsible and the frame is collapsed after completing the inspecting step

4. The method of claim 1, wherein a frame includes one or more handle portions that can be grasped by a user for the insertion step.
 5. The method of claim 1, wherein larvae or pupae of aquatic insects are collected and a fly-type lure is selected based on the collected larvae or pupae.
 6. The method of claim 1, wherein aquatic insects are collected and a fly-type lure is selected based on the where the collected aquatic insects are located on the screen.
7. A screening device for determining fishing conditions comprising:
- a) a frame having a pair of side rails and at least two cross members, the cross members interconnecting the pair of side rails, the side rails include at least one handle portion and one support portion;
 - b) a flexible screen having opposing ends and opposing sides, each opposing side aligned and attached to a respective side rail, at least one opposing end being a free end and extending between the pair of side rails, the flexible screen having a width such that the free end is curved in shape during use.
8. The screening device of claim 7, wherein each cross member further comprises:
- a pair of cross member segments, each segment pivotally attached to a side rail at one end, other ends of each segment pivotally attached together so that the cross member segments and side rails can fold up.

9. The screening device of claim 7, wherein each end of the screen is free and curved in shape during use.
10. The screening device of claim 7, wherein the cross members and side rails are immobile with respect to each other when the side rails are interconnected by the cross members.
11. The screening device of claim 8, wherein the cross member segments lock to keep the side rails spaced apart for collecting purposes.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.